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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,724	01/15/2004	Paul H. Morrill	05525/00003/US1	4582

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EXAMINER

PATEL, JAGDISH

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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04/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/757,724	Applicant(s) MORRILL, PAUL H.	
	Examiner JAGDISH N. PATEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 164-199, 201-213, 216-219 and 221 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 164-195 is/are allowed.
- 6) ☒ Claim(s) 196-199, 201-213, 216-219 and 221 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

[Note: The Applicant is reminded to submit a supplemental Reissue Declaration which addresses any new amendment reflecting errors being corrected at the time of allowance using specific language from the patent.]

1. This communication is in response to amendment filed 1/12/10.

Response to Amendment

2. Amendment to the pending claims is acknowledged. Claims 164-199, 201-213 and 216-219 and 221 are currently pending.

Claim Objections

3. Claims are objected to because of the following informalities:

Claims 200, 214-215 and 220 status should be indicated as "(Cancelled)".

Appropriate correction is required.

Response to Arguments

4. Applicant's arguments with respect to rejections of claims 164-221 under 35 USC 112(first and second paragraphs) are persuasive and accordingly these rejections have been withdrawn.

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5. Rejection of claims 164-195 under 35 USC 101 has been withdrawn. However, rejection of claims 196-199, 201-213, 216-219 and 221 under 35 USC 101 has been maintained. (See explanation below.)

Claim Rejections - 35 USC § 101

6. Claims 196-199, 201-213, 216-219 and 221 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

[Exemplary claim 196 is analyzed. The analysis applies to all of the aforementioned claims.]

In order for a process to be statutory under 35 U.S.C. 101 it must (1) be tied to another statutory class (such as a particular apparatus or machine) or (2) transform underlying subject matter (such an article or materials) to a different state or thing. See recent decision by The U.S. Court of Appeals for the Federal Circuit decision in *Bilski* which established Machine-Or-Transformation Test for statutory process. Prior to this in *Gottschalk v. Benson*, 409 U.S. 63, 71, 93 S.Ct. 253, 34 L.Ed.2d 273 (1972), the Supreme Court reiterated the proposition that "a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a `different state or thing.'" The Court referred to the well established definition of "process" stated in *Cochrane v. Deener*, 94 U.S. 780, 788, 24 L.Ed. 139 (1877). "A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing." Alternatively, "A process is a mode of treatment of certain materials to produce a given result. It is an act, a series of acts, performed upon

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the subject-matter to be transformed and reduced to a different state or thing.” 308 F.3d 1304 *Schumer v. Laboratory Computer Systems Inc.*, 64 USPQ2d 1832, 1838 n.6 (Fed. Cir. 2002).

In the instant case, none of the process steps of the method claims are tied to an apparatus such as a computer, nor do they transform a subject matter to a different state or thing. In an exemplary claim 196, use of the wireless device is merely to collect data (a message including a function code) is treated as a nominal recitation of an apparatus akin to *Comiskey* which stated that “the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter.” *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). (See also *Ex Parte Langemyr*, Appeal 2008-1495, BPAI Decision May 28, 2008).

In other words, the mere presence of a machine tie is not sufficient to pass the Machine-Or-Transformation test under *Bilski*. When a machine tie has been identified, it must be further determined that the tie is to a particular machine.

The particular machine tie must meet two corollaries to pass the test for 101 eligibility. First, the use of the particular machine must impose a meaningful limit on the claim's scope. Such a machine tie in only a field-of-use limitation would not be sufficient. Second, the use of the particular machine must involve more than insignificant “extra-solution” activity. If the machine is only present in a field-of-use limitation or in a step that is only insignificant “extra-solution” activity, the claim fails the M-or-T test, despite the presence of a machine in the claim.

In the instant claim 196, the use of the wireless device is limited to gathering data (receiving a message) which is treated as "extra-solution" activity. There is no other recitation of the wireless device or any other machine (or apparatus) in the scope of the claim. Thus, the use of the wireless device does not impose a meaningful limit on the claimed invention.

Based on the foregoing analysis, it is concluded that claims 196-199, 201-213, 216-219 and 221 are not eligible subject matter under 35 USC 101 for patentability.

Claim Rejections - 35 USC § 112

7. Claims 196-199, 201-213, 216-219 and 221 rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed.

As an example, claim 196 recites that in response to receipt of the function code and user identification, the desired funds transfer between accounts, are authorized which authorizing include determining a source account from the user identification.

However, this entire process is performed manually and without involvement of any electronic device.

The specification does not support the best mode of operation contemplated by the inventor because requisite process is accomplished only with a CPU linked to the wireless device.

The foregoing rationale is also applicable to other rejected claims mentioned above.

Allowable Subject Matter

Claims 164-195 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on Monday – Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Primary Examiner, Art Unit 3693